

REMARKS

Status of the claims:

With the above amendments, claims 1 and 3-8 have been amended and claims 9-15 have been added. Claims 1-15 are pending and ready for further action on the merits. No new matter has been added by way of the above amendments. Reconsideration is respectfully requested in light of the following remarks.

Rejections under 35 USC §§101 and 112, second paragraph

Claims 4-6 have been rejected under 35 USC §§101 and 112, second paragraph for reciting "use" claims. Applicants have amended all these claims so that they no longer appear as "use" claims. Applicants believe that with this amendment the rejection has been obviated. Withdrawal of the rejection is warranted and respectfully requested.

Claim 8 has been rejected under 35 USC §112, second paragraph as being indefinite because the Examiner does not know how it is dependent from claim 1. Applicants have amended claim 8 to make it properly dependent from claim 1. Withdrawal of the rejection is warranted and respectfully requested.

Rejections under 35 USC §102

Claims 1 and 7 are rejected under 35 USC §102(b) as being anticipated by Benecke '502 (EP 0 872 502 A1). The Examiner asserts that the polyurethane prepolymers in Benecke '502 overlap with the claimed ranges in the composition of the instant invention.

Applicants traverse.

Benecke '502 discloses film forming materials to be used for coating substrates. See page 2, lines 48-57. In Benecke '502, the last process step is directed to a chain lengthening step and not a crosslinking step. The polyurethanes of Benecke '502 are obtained as dispersion forming on drying a film. Please see page 5, lines 51-56 in Benecke '502. An isolation of filler particles from the dispersion is not possible. All dispersions described in the examples of Benecke '502 show a certain viscosity (please see page 6, line 42 and page 7, line 16 in Benecke '502) and use ethylene diamine as component D. On page 6, lines 1-2 in Benecke '502, it is mentioned that fillers can be added to the dispersion.

In contrast to Benecke '502, the instant invention is directed to a filler, which is not film forming. A filler does not have a viscosity. This is because in the last process step of the present invention, a crosslinking reaction takes place. Crosslinked materials do not have film-forming properties.

Thus, it should be apparent to those of ordinary skill in the art that the product of the instant invention is different from the product of Benecke '502. For this reason alone, the rejection is inapposite. Withdrawal of the rejection is warranted and respectfully requested.

It is noted, however that Benecke '502 mentions on page 5, lines 31-37 that a chain-lengthener or a crosslinker can be used as component D). Benecke '502 discloses triamines as possible crosslinkers. However, the intended use of Benecke '502's invention teaches away from the use of triamines or crosslinkers. As was explained above, Benecke '502 desires film-forming properties. The use of crosslinking agents such as triamines will not allow one to form film-forming properties. Thus, one of ordinary skill in the art would never use the triamines that are disclosed by Benecke '502 to form a film-forming material. Withdrawal of the rejection is warranted and respectfully requested.

With the above remarks and amendments, Applicants believe that the claims, as they now stand, define patentable subject matter such that passage of the instant invention to allowance is warranted. A Notice to that effect is earnestly solicited.

If any questions remain regarding the above matters, please contact Applicant's representative, T. Benjamin Schroeder (Reg.

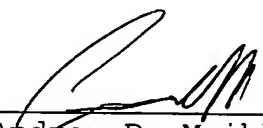
No. 50,990), in the Washington metropolitan area at the phone number listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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